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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/630,905

07/31/2003

John J. Donahue

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04/26/2006

BANNER & WITCOFF

1001 G STREET N W

SUITE 1100

WASHINGTON, DC 20001

EXAMINER

SINGH, RACHNA

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/630,905

Applicant(s)

DONAHUE, JOHN J.

Examiner

Rachna Singh

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/13/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Remarks filed on 02/13/06.
2. Claims 1-33 are pending. Claims 1, 20, 27, 31, and 33 are independent claims.

Response to Amendment

3. The affidavit filed on 02/13/05 under 37 CFR 1.131 has been considered but is ineffective to overcome the Ghai and Abraham-Fuchs reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Ghai or Abraham-Fuchs reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

On pages 1-4 of the Affidavit, Applicant declares conception before the priority dates of both the Ghai and Abraham-Fuchs reference with subsequent due diligence until the filing of the patent application. It is noted that Applicant has submitted various exhibits; however, the affidavit submitted is insufficient because it makes broad, general statements without explaining how exactly the exhibits teach the specific claim limitations. As discussed in MPEP 715.07, the affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms

about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of **37 CFR 1.131(b)**. *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964). For example, On page 1 of the Declaration, Applicant states, "Conception is evidenced by the document entitled "Memo"; however, there is no clear explanation of how the exhibit teaches the specific claim limitations. The Declaration contains other similar statements such as on page 2 where Applicant refers to an email, written notes/comments about a draft patent application without explaining how the exhibits teach specific claim limitations.

Although the Applicant is relying on conception followed by due diligence, it is noted the evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Ghai and Abraham-Fuchs reference as well. This affidavit fails to recite sufficient facts for the examiner to determine: (a) which of the claim limitations are satisfied by the prototype; (b) whether the test conditions represented actual conditions or realistically simulated conditions; (c) whether the test results demonstrate that the test was in fact successful; and (d) whether the test results, if successful, were also reproducible.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 6-18, and 20-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ghai et al., US 2005/0120330 A1, 06/02/05 (filed 07/12/04, provisional application filed 07/11/03).

In reference to claims 1, 20, 27, 31, and 33, Ghai teaches a system and method for creating and using self-describing events in automation. Ghai teaches the following:

-Receiving a response, processing the response which can include selecting event types to be used as triggers for steps in an automated workflow. Attributes of events can be selected as arguments to workflow steps. One way the processing can occur is to present the data type information to a user and allow this user to manually select which event types will trigger steps in the automated workflow and which event attributes will be passed as arguments to the workflow steps. See page 2, paragraph [0012]. Compare to **"detecting user-selected text portions of the displayed text document and detecting at least one user-selected workflow process parameter associated with each user-selected text portion of the document"**.

-Defining the workflow using the steps above and monitoring the components for events defined in the workflow. When an event is detected it is processed. Processing of an

event includes creating a machine readable data payload containing event information including the event type, event attributes, and a grammar to which the event conforms. Using the provided grammar, components in the automated workflow can interpret the data payload and perform the actions defined in the automated workflow. See page 2, paragraphs [0012]-[0013]. The data payload is in XML form with an associated XML schema attached to the event. See page 3, claims 1-4. Compare to ***“converting user-selected. . .into a data structure representing an ordering of information to be elicited when the workflow process is executed; and using the data structure to drive the workflow process”***.

Ghai does not expressly state the user-selected text portions; however, he does teach allowing a user to manually select which event types will trigger steps in the automated workflow and which event attributes will be passed as arguments to the workflow steps. See page 2, paragraph [0012]. It would have been obvious to a person of ordinary skill in the art at the time of the invention to realize that the event types that trigger steps in the automated workflow are passed as arguments which can comprise text portions. See page 1, paragraph [0003] where Ghai teaches the text message format for the event is changed through updates to the system, the parsing routine must also be changed to allow the data to be extracted.

In reference to claims 2-3, Ghai teaches defining the workflow using the steps above and monitoring the components for events defined in the workflow. When an event is detected it is processed. The processing of an event includes creating a machine-readable data payload containing event information including the event type,

event attributes, and a grammar to which the event conforms. Ghai further teaches using the provided grammar, components in the automated workflow can interpret the data payload and perform the actions defined in the automated workflow. See page 2, paragraphs [0012]-[0013]. See page 3, claims 1-4.

In reference to claims 10-12, Ghai teaches allowing a user to manually select which event types will trigger steps in the automated workflow and which event attributes will be passed as arguments to the workflow steps. See page 2, paragraph [0012].

In reference to claim 13, Ghai teaches the data payload is in XML form with an associated XML schema attached to the event. See page 3, claims 1-4.

In reference to claim 14, Ghai teaches the system also includes a graphical viewer in communication with the web browser client. The graphical viewer is operative to display event type information including producible event types of managed components, attributes of each event type, and a grammar to which each event type conforms. See page 2, paragraph [0011].

In reference to claim 16, Ghai teaches processing the data payload in a manner defined by the workflow by using the provided grammar of the event type to interpret the attributes of the event. See page 2, paragraph [0013].

In reference to claim 17, Ghai teaches allowing a user to manually select which event types will trigger steps in the automated workflow and which event attributes will be passed as arguments to the workflow steps. See page 2, paragraph [0012].

In reference to claims 23-26, Ghai discloses allowing a user to manually select which event types will trigger steps in the automated workflow and which event attributes will be passed as arguments to the workflow steps. See page 2, paragraph [0012].

In reference to claim 28, Ghai teaches the data payload is in XML form with an associated XML schema attached to the event. See page 3, claims 1-4.

In reference to claims 29-30, Ghai discloses allowing a user to manually select which event types will trigger steps in the automated workflow and which event attributes will be passed as arguments to the workflow steps. See page 2, paragraph [0012]. Ghai's system also includes a graphical viewer in communication with the web browser client. The graphical viewer is operative to display event type information including producible event types of managed components, attributes of each event type, and a grammar to which each event type conforms. Pursuant to this aspect of the current application, a server application is provided. The server application is in communication with the web browser client and with an event database and an event application. The server application is operative to receive a request for event type information, query the event application and access the event database to respond to a request for event type information. A remote data server is in communication with the graphical viewer. The remote data server is further in communication with at least one platform-specific event database. The remote data server is operative to receive a request for platform-specific event type viewing data and is operative to query the

platform-specific event database and respond to the request for platform-specific event viewing data.

In reference to claims 4 and 7-9, Ghai teaches a user can manually select which event types will trigger steps in the workflow and which event attributes will be passed as arguments to the workflow process; however, he does not expressly state the parameters comprise questions to be asked during step 3. It would have been obvious to a person of ordinary skill in the art at the time of the invention that defining the event attributes to be passed as arguments to the workflow process could comprise questions because the user could define the parameters as such.

In reference to claim 6, Ghai teaches a user can manually select which event types will trigger steps in the workflow and which event attributes will be passed as arguments to the workflow process; however, he does not expressly state the user can modify a label used to designate a phase; however, it would have been obvious to a person of ordinary skill in the art at the time of the invention that defining the event attributes to be passed as arguments to the workflow process could comprise modifying a label used to designate a phase since Ghai's system allows users to select and define the workflow process.

In reference to claims 15 and 18, Ghai teaches a user can manually select which event types will trigger steps in the workflow and which event attributes will be passed as arguments to the workflow process; however, he does not expressly state the parameters comprise questions to be asked during step 3. It would have been obvious to a person of ordinary skill in the art at the time of the invention that defining the event

attributes to be passed as arguments to the workflow process could comprise questions because the user could define the parameters as such.

In reference to claims 21-22 and 32, Ghai teaches a user can manually select which event types will trigger steps in the workflow and which event attributes will be passed as arguments to the workflow process; however, he does not expressly state the parameters comprise questions to be asked during step 3. It would have been obvious to a person of ordinary skill in the art at the time of the invention that defining the event attributes to be passed as arguments to the workflow process could comprise questions because the user could define the parameters as such.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ghai et al., US 2005/0120330 A1, 06/02/05 (filed 07/12/04, provisional application filed 07/11/03) in view of McKibben et al., US 2004/0122835 A1, 06/24/2004 (provisional filed 12/11/02).

In reference to claim 5, Ghai does not teach a drop-down menu containing workflow process parameters; however, McKibben teaches a drop down menu allowing a user to select different folders. See page 9, paragraph [0113]. Although McKibben's drop down menu does not contain workflow process parameters, he teaches that dropdown menus were a well-known method in the art to select from a variety of options and it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate a drop-down menu for parameter selection as it is an efficient way to interactively make a selection.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ghai et al., US 2005/0120330 A1, 06/02/05 (filed 07/12/04, provisional application filed 07/11/03) in view of Abraham-Fuchs et al., US 2004/0260593 A1, 12/23/04 (filed 05/19/04, provisional filed 05/20/03).

In reference to claim 19, Ghai does not teach using voice recognition to detect the at least one workflow process parameter; however, Abraham-Fuchs does. Abraham-Fuchs discloses a user interface supporting workflow operation improvement where the user interface comprises a voice recognition program for recognizing input received via a graphical user interface. See page 2, paragraphs [0015]-[0016]. It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate a voice recognition system to detect a workflow process parameter as it is inputted to the system by a user and it is desirable to identify such input in the system of Ghai in order to drive the workflow process.

Response to Arguments

8. Applicant's arguments filed 04/19/06 have been fully considered but they are not persuasive. Applicant argues the priority date of the Ghai and Abraham-Fuchs reference is invalid in view of the Declaration under 37 C.F.R. 1.131. Examiner disagrees in view of the comments made above under "Response to Amendment" with regards to the Declaration under 37 C.F.R. 1.131. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Ghai or Abraham-Fuchs reference. While conception is the mental part of the inventive

act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

In view of the comments above, the rejection is maintained.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachna Singh whose telephone number is 571-272-4099. The examiner can normally be reached on M-F (8:30AM-6:00PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2176

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RS
04/19/06

A handwritten signature in black ink, appearing to read 'D. Hutton', with a stylized flourish at the end.

Doug Hutton
Primary Examiner
Art Unit 2176